

INTERVIEW SUMMARY

During the interview conducted on December 23, 2008, Applicant and Examiner discussed the scope of the current claims, which the Examiner suggested should be amended to reference a specific environment or art. Applicant and Examiner also discussed the pending rejections under 35 U.S.C. §§ 101 and 103(a). In regard to the rejection pursuant to § 101, the Examiner suggested amending the pending claims to clarify that the claimed invention is tied to another statutory class, such as a computer. In regard to the § 103(a) rejection, Applicant and Examiner discussed U.S. Patent No. 7,177,831 issued to O'Shaughnessy *et al.* (hereinafter "*O'Shaughnessy*"). The Examiner clarified that U.S. Patent No. 7,249,080 did not form part of the basis for the § 103(a) rejection. Applicant attempted to explain the differences between the claimed invention and the system disclosed in *O'Shaughnessy*. Applicant appreciates the opportunity to discuss the Application with the Examiner.

REMARKS

Favorable reconsideration and allowance of the present Application are respectfully requested. Claims 1-69 are currently pending in the present Application.

I. Environment of the Claimed Invention

During the interview, the Examiner suggested amending the claims to recite an environment in which the claimed invention is used. Pursuant to the Examiner's suggestion, Applicant has amended the claims to recite that the claimed invention is directed to selecting between a plurality of investment alternatives in order to facilitate

prosecution of the present Application but expressly retains the right to pursue claims in the form as originally filed.

II. 35 U.S.C. § 101

Claims 1-64 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. During the interview, the Examiner suggested amending the pending claims to clarify that the claimed invention is tied to another statutory class, such as a computer. Applicant has amended the pending claims in order to clarify that the claimed invention is tied to another statutory class.

III. 35 U.S.C. §103(a)

The Office Action rejected claims 1-69 under 35 U.S.C. § 103(a) as being unpatentable over *O'Shaughnessy*. Applicant respectfully traverses this basis of rejection for at least the reasons set forth below.

Independent claims 1 and 28 are directed to computerized methods for selecting between or allocating among a plurality of investment alternatives. Independent claim 37 is directed to computer-readable medium having computer-executable instructions for performing a method for selecting between a plurality of investment alternatives. Independent claims 48 and 59 are directed to systems for selecting between or allocating among a plurality of investment alternatives.

Among other elements, claims 1, 28, and 37 require presenting attributes of the investment alternatives for selection by the user, selecting a relative importance of the selected attributes, selecting a degree of preference for each selected attribute with

respect to at least one other of the selected attributes, and determining a quantitative value of importance for each of the selected attributes relative to the other selected attributes based upon both the relative importance and the degree of preference for each of the selected attributes. Claims 1, 28, and 37 additionally require generating a ranking of the investment alternatives in response to these quantitative values of importance, as well as the user's risk tolerance.

Similarly, claim 48 requires a user interface adapted to present the plurality of attributes related to the investment alternatives for selection by the user, an analysis program adapted to determine a relative importance for each selected attribute, a degree of preference for each selected attribute with respect to at least one other selected attribute, and a quantitative value of importance for each selected attribute relative to the other selected attributes, and a processor programmed to generate a ranking of the investment alternatives in response to a combination of the risk tolerance of the user and the quantitative value of importance of each selected attribute.

Claim 59 requires a user interface generator adapted to present a plurality of attributes related to the plurality of investment alternatives for the user to select attributes of importance to the user, and a utilities calculation engine to determine a relative important for each selected attribute, a degree of preference for each selected attribute with respect to at least one other attribute, and a quantitative value of important for each selected attribute relative to the other selected attributes. Claim 59 also requires the utilities calculation engine to generate a ranking of the investment

alternatives in response to a combination of the user's risk tolerance and an analysis of the quantitative values of importance.

In contrast, *O'Shaughnessy* does not disclose a system or method where a ranking of investment alternatives is generated based on a user's risk tolerance and a qualitative value of importance for each selected attribute relative to the other selected attributes. Furthermore, *O'Shaughnessy* does not disclose a system or method where a quantitative value is itself based on two values: (1) a relative importance for each selected attributed and (2) a degree of preference for each selected attribute with respect to at least one other selected attribute. *O'Shaughnessy* discloses a system where a "user is given a risk questionnaire." *O'Shaughnessy*, col. 9, lines 14-15. The user's responses are scored "to determine a suitable, tailored allocation recommendation, [which] consists of recommendations of percentage investment in cash, fixed income instruments and equities of domestic and foreign domicile." *O'Shaughnessy*, col. 9, lines 23-26. The investment recommendation is solely in response to the risk questionnaire. *O'Shaughnessy* fails to disclose or suggest (1) selecting a relative value of importance for each selected attributed, (2) selecting a degree of preference value for each selected attribute with respect to at least one other selected attribute, (3) determining a qualitative value of importance of each selected attribute relative to the other selected attributes based on both numbers 1 and 2, and (4) generating a ranking of investment alternatives based on the user's risk tolerance in combination with number 3.

The Office Action states that, because a ranking usually involves a value of importance, the claimed function of determining a quantitative value would have been obvious to try because *O'Shaughnessy* teaches ranking of the plurality of strategies and recommended strategies selected by the user. The recommendation in *O'Shaughnessy*, however, is only based on the user's answers to the risk questionnaire. Even if accepting as true that the ranking of alternatives inherently involves determining a quantitative value of importance for each selected attribute, which Applicant does not, *O'Shaughnessy* only discloses providing recommendations based on the answers to a risk questionnaire, thereby making any inherent determination of quantitative values for each selected attribute based on the user's risk tolerance. Nonetheless, even if *O'Shaughnessy* inherently involves a value of importance not based on the user's risk tolerance but based on something else, which Applicant does not believe it does, *O'Shaughnessy* does not disclose or teach that the values of importance are based on both a relative importance of each selected attribute and a degree of preference of each selected attribute with respect to at least one other selected attribute, as required by the claimed invention. In this regard, *O'Shaughnessy* fails to disclose or suggest determining any importance value of an attribute with respect to any of the others as required by the claimed invention. Thus, *O'Shaughnessy* cannot disclose or suggest a ranking of alternatives based on both the user's risk tolerance and something else. Furthermore, *O'Shaughnessy* fails to disclose or suggest determining either a relative

importance or a degree of preference, especially a degree of preference for each selected attribute with respect to at least one other selected attribute.

Because *O'Shaughnessy* fails to disclose multiple elements of the independent claims, and because it would not have been obvious to one of ordinary skill in the art to combine the multiple missing elements with the system disclosed in *O'Shaughnessy*, the independent claims are not unpatentable over *O'Shaughnessy*. The remaining claims are dependent thereon, recite additional elements, and are therefore patentable in their respective combinations.

IV. Conclusion

For the reasons stated above, it is respectfully submitted that claims 1-69 are not unpatentable over *O'Shaughnessy*. As all outstanding rejections have been addressed, favorable action by the Examiner and withdrawal of the cited rejections is respectfully requested. The Examiner is invited to call the undersigned in an effort to discuss and resolve any remaining issues.

Respectfully submitted,

NELSON MULLINS RILEY & SCARBOROUGH, LLP.

/s Jeremy C. Whitley
Jeremy C. Whitley
Registration No. 58,775
ip@nelsonmullins.com
1320 Main Street | Suite 1700
Columbia, South Carolina 29201
Direct.803.255.9764 | Fax.803.255.9831